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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,866	01/30/2004	Jean-Louis Gueret	118322	3899
25944	7590	10/30/2007	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				WALCZAK, DAVID J
ART UNIT		PAPER NUMBER		
3751				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/766,866

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 22 October 2007.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-19,21-25,27-31 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 8, 9 and 17 is/are withdrawn from consideration.
- 5)  Claim(s) 37 and 38 is/are allowed.
- 6)  Claim(s) 1,4-7,10-16,18,19,21-25,28-31 and 34-36 is/are rejected.
- 7)  Claim(s) 27 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some \*
  - c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Objections***

Claims 27, 28, 37 and 38 are objected to because of the following informalities:

It is unclear as to what limitations the phrase “to within about 30%” is intended to define.

For example, in regard to claims 28 and 37, it appears that the applicator element can have a length that is 30% longer than the length of the flask body, have a length that is 30% shorter than the length of the flask body or have a length that is somewhere in between these two limits. In regard to claims 27 and 38, it appears that the stem can have a length that is 30% longer than the length of the neck, have a length that is 30% shorter than the length of the neck or have a length that is between these two limits.

For the purposes of examination, this limitation will be construed as discussed above.

The Applicant should clarify the claim language and/or the language in the specification such that it is clear as to what structure the limitation “to within about 30%” is intending to defined. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31 and 34-36 are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter. These claims are non-statutory in that they are directed to neither a process or a machine, but rather embrace two different statutory classes of invention. See MPEP 2173.05(p) II

### ***Claim Rejections - 35 USC § 112***

Claims 28, 31 and 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 28, an antecedent basis for “the flask body” has not been defined. Accordingly, it is unclear as to whether or not the neck is part of the flask body or is a separate element extending from the flask body (see claim 37, lines 2-3, which provides adequate support for “the flask body” defined later in the claim).

In regard to claims 31 and 34-36, these claims are indefinite in that both an apparatus and method are being defined. See MPEP 2173.05(p) II.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made:

Claims 1, 4-7, 10-16, 18, 19, 21-25, 29-31 and 34-36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al. (hereinafter Buckley) in view of

Drozd, Jr. (hereinafter Drozd). In regard to claim 1, Buckley discloses a device comprised of a flask 10 containing “a substance for application to nails” (see column 2, lines 6-7) and having a threaded neck 14 and an applicator having a fixed length stem 21 and/or 21’ (see Figure 7), an applicator element (comprised of elements 22’ 12’) disposed at the first end of the stem and a closure cap 11 supporting the second end of the stem wherein the cap includes a threaded portion for engagement with the neck 14. Although the Buckley reference does not disclose the volume of the flask, it is the Examiner’s position that the flask in the Buckley reference can be designed to have any suitable volume, including the claimed volume, without effecting the overall operation of the device, especially since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable condition (in this case, the flask volume) involves only routine skill in the art. It is further noted that the Applicant has placed no criticality on the particular flask volume. Although the Buckley reference does not disclose a ring releasably connected to the threaded portion and arranged to remain secured to the neck during removal of the applicator, attention is directed to the Drozd reference, which discloses another flask and cap arrangement wherein a ring 16a (see Figures 8-10) is releasably connected to the threaded portion of the cap 12 and will remain secured to the neck of the flask when the cap is removed in order to enable a user to determine whether or not the cap has been previously removed. Further, the ring occupies “substantially” the same axial position before and after separation, i.e., when compared to the length of the neck and container, the ring remains in “substantially” the same position. Accordingly, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to provide the structure of the flask neck and ring taught by Drozd onto the Buckley device in order to enable a user to determine whether or not the device has previously been open. In regard to claim 4, the ring has a first portion 52 in relief that enables the ring to be snap-fastened onto a second portion 54 in relief on the neck (see column 7, lines 12-18). In regard to claim 5, the second portion in relief includes an annular bead 54 and the first portion in relief comprises teeth 52. In regard to claim 6, the ring and cap disclosed by Drozd are formed by molding plastic (as evidenced by the cross-hatching used in the drawings and column 4, lines 36-39). In regard to claim 7, the ring is connected to the threaded portion by a breakable bridge 14a. In regard to claims 10-12 and 16, the neck includes a first anti-rotation device 44a in the form of a ramp and the ring includes a second anti-rotation device 28a in the form of a ramp wherein the anti-rotation devices operate as claimed. In regard to claim 13, the neck in the Buckley device includes a base having a cylindrical surface (located below the threads). In regard to claim 14, a careful inspection of Figure 1 shows frostoconical surface at the base which flares toward the body of the flask. In regard to claim 15, the flask in the Buckley device has a shoulder at the base of the neck. In regard to claims 18 and 19, the flask in the Buckley device can be made from glass or plastic (see column 1, lines 48-52). In regard to claims 21, 22, 24 and 25 although the Buckley reference does not disclose the capacity of the flask or the dimensions of the stem and applicator brush, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to design the flask to have the claimed capacity and

the neck, stem and applicator to have the claimed dimensions, depending on the needs of the user. In regard to claim 23, the stem is visible when the applicator is withdrawn and viewed as claimed (see Figure 7). In regard to claims 29 and 30, the claimed method of manufacturing the device is inherent in the manufacturing of the device discussed *supra*. In regard to claims 31 and 34-36 the method as claimed is inherent in the operation of the device discussed *supra*.

Claims 1, 4-7, 10-16, 18, 19, 21-25, 29-31 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Yasada. In regard to claim 1, Buckley discloses a device comprised of a flask 10 containing "a substance for application to nails" (see column 2, lines 6-7) and having a threaded neck 14 and an applicator having a fixed length stem 21 and/or 21' (see Figure 7), an applicator element (comprised of elements 12', 22') disposed at the first end of the stem and a closure cap 11 supporting the second end of the stem wherein the cap includes a threaded portion for engagement with the neck 14. Although the Buckley reference does not disclose the volume of the flask, it is the Examiner's position that the flask in the Buckley reference can be designed to have any suitable volume, including the claimed volume, without effecting the overall operation of the device, especially since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable condition (in this case, the flask volume) involves only routine skill in the art. It is further noted that the Applicant has placed no criticality on the particular flask volume. Although the Buckley reference does not disclose a ring releasably connected to the threaded portion and arranged to remain secured to the neck during

removal of the applicator, attention is directed to the Yasada reference, which discloses another flask and cap arrangement wherein a ring 24 is releasably connected to the threaded portion of the cap 16 and will remain secured to the neck of the flask when the cap is removed in order to enable a user to determine whether or not the cap has been previously removed. Further, due to element 12 the ring occupies substantially the same axial position before and after separation. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the structure of the flask neck and ring taught by Yasada onto the Buckley device in order to enable a user to determine whether or not the device has previously been open. In regard to claim 4, the ring has a first portion 34 in relief that enables the ring to be snap-fastened onto a second portion 10 in relief on the neck. In regard to claim 5, the second portion in relief includes an annular bead 10 and the first portion in relief comprises teeth 34. In regard to claim 6, the ring and cap disclosed by Drozd are formed by molding plastic (as evidenced by the cross-hatching used in the drawings and column 3, lines 64-66). In regard to claim 7, the ring is connected to the threaded portion by a breakable bridge 28. In regard to claims 10-12 and 16, the neck includes a first anti-rotation device 34 in the form of a ramp and the ring includes a second anti-rotation device 38 in the form of a ramp wherein the anti-rotation devices operate as claimed. In regard to claim 13, the neck in the Buckley device includes a base having a cylindrical surface (located below the threads). In regard to claim 14, a careful inspection of Figure 1 shows frostoconical surface at the base which flares toward the body of the flask. In regard to claim 15, the flask in the Buckley device has a shoulder

at the base of the neck. In regard to claims 18 and 19, the flask in the Buckley device can be made from glass or plastic (see column 1, lines 48-52). In regard to claims 21, 22, 24 and 25, although the Buckley reference does not disclose the capacity of the flask or the dimensions of the stem and applicator brush 12', at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to design the flask to have the claimed capacity and the neck, stem and applicator to have the claimed dimensions, depending on the needs of the user. In regard to claim 23, the stem is visible when the applicator is withdrawn and viewed as claimed (see Figure 7). In regard to claims 29 and 30, the claimed method of manufacturing the device is inherent in the manufacturing of the device discussed supra. In regard to claims 31 and 34-36 the method as claimed is inherent in the operation of the device discussed supra.

### ***Allowable Subject Matter***

Assuming that the Examiner's above discussed interpretation of the limitation "to within about 30%" is correct, claims 37 and 38 are allowed.

Assuming that the Examiner's above discussed interpretation of the limitation "to within about 30%" is correct, claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Assuming that the Examiner's above discussed interpretation of the limitation "to within about 30%" is correct, claim 28 would be allowable if rewritten to overcome the

rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 10/22/07 have been fully considered but they are not persuasive.

The Applicant contends that the Buckley reference is not applicable against the claims in that the stem therein is extendable and not of a "fixed length" (as claimed). However, as discussed in detail above, elements 21 and 21' of Buckley are relied upon to define the stem and these elements are considered to be of a fixed length.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Gueret '996 reference is cited for disclosing an applicator which includes a fixed length stem between the cap and the brush. It is noted that, similar to the Buckley device, this device can be modified to have the same ring structure that is recited in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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10/26/07